

In The
Supreme Court of the United States

October Term 1978

No. 78-454

VLADIMIR HENRY PAVLECKA and
JOHN PAVLECKA,

Petitioners.

vs.

DONALD W. BANNER,
COMMISSIONER OF PATENTS
AND TRADEMARKS,

Respondent.

**PETITION FOR WRIT OF
CERTIORARI TO THE UNITED STATES
COURT OF CUSTOMS AND PATENT APPEALS**

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Now come the Petitioners, VLADIMIR HENRY PAVLECKA and JOHN PAVLECKA, by their attorneys, and pray that a WRIT OF CERTIORARI be issued to review the Decision entered February 9, 1978 by the United States Court of Customs and Patent Appeals IN THE MATTER OF THE APPLICATION OF VLADIMIR HENRY PAVLECKA AND JOHN PAVLECKA. A Petition for Rehearing was denied April 27, 1978.

OPINIONS

The Opinion of the Court of Customs and Patent Appeals is attached hereto as Appendix A. This Decision is unreported.

The Order Denying Rehearing is attached hereto as Appendix B.

The Opinion and Decision of the Board of Appeals, dated August 20, 1976, is attached hereto as Appendix C.

JURISDICTION

The Opinion of the United States Court of Customs and Patent Appeals was entered on February 9, 1978. The date of the Order Denying Rehearing was April 27, 1978. This Petition for a Writ of Certiorari was filed within the extended time provided by the Order of this Court of July 19, 1978. The jurisdiction of this Court is invoked under 28 U.S.C. 1256.

QUESTIONS PRESENTED

1. Whether the practice of the Patent Office in refusing to consider non-species claims withdrawn by a requirement for restriction is authorized by 35 U.S.C. 121 upon which it relies in 809.02(a) M.P.E.P.

2. Whether the practice of the Patent Office in limiting Petitioners to claims for species that read upon one figure elected under a requirement for restriction and

refusing to prosecute all non-species claims, is authorized by 35 U.S.C. 121.

3. Whether the practice of "restriction" of the Patent Office, by which the status of all non-species claims is altered semantically into that of "species" by associating them with drawing figures referred to arbitrarily as "species", is authorized by 35 U.S.C. 121.

4. Whether the practice of the Patent Office not to recognize the presence and the right to examination of non-species claims withdrawn by it under a requirement for restriction as being for "non-elected species", is valid under 35 U.S.C. 121.

5. Whether the use of the term "species" by the Patent Office with reference indiscriminately to all drawing figures and to all claims is valid under the dictionary and Corpus Juris Secundum definition that it is applicable only to conceptions having a genus.

6. Whether claims not having a genus and not readable on one elected species figure are seizable and excludable from an application by the Patent Office on those grounds and given to the public under 35 U.S.C. 121 or under 37 C.F.R. 1.141, 1.142 or 1.146 or under 809.02(a) M.P.E.P.

7. Whether the reference to claims for species as being for "independent and distinct" inventions and allowing up to five such species under a generic claim is consistent with and valid

under 35 U.S.C. 121 in view of the obvious inconsistency under 35 U.S.C. 6.

8. Whether, in view of several confused, indefinite, and even contradictory definitions of "independent" and "distinct" in the M.P.E.P., and the absence of any guidelines to the meaning of those terms in 35 U.S.C. 121, "independent" should not be adjudged to refer to the tangible, mechanical, structural or assembled form of a product or substance, and "distinct" to the effect, result or function produced; under those definitions species would be independent but not distinct inventions patentable together.

9. Whether the broad, loose, and imprecise terms and phrases "all claimed species" in 37 C.F.R. 1.141 and "to which his claims shall be restricted" in 37 C.F.R. 1.146 and in 809.02(a), paragraph (3), M.P.E.P., do not render these regulations indefinite and, therefore, invalid as restrictive and rejective grounds for non-species claims by the stratagem of verbally altering their status into "species".

10. Whether the affirmance by the Court of Customs and Patent Appeals of the rejection of the eight appealed claims on the "sole issue" of alleged lack of readability on one "elected species" figure has any support in a statute or valid regulation by a requirement that all application claims, both species and non-species, read on such a figure.

11. Whether the affirmance by

the Court of Customs and Patent Appeals of the rejection of the appealed claims on grounds that they are for "separately identified inventions" in certain drawing figures are new grounds heretofore not alleged or argued in this case.

12. Whether the "sole issue" rejecting and affirming ground of the Board of Appeals and of the Court of Customs and Patent Appeals, respectively, of the rejected claims not being readable on the "elected species" figure, and the Court's new ground of the claims being for "separately identified inventions" in stated drawing figures not directed to the "elected invention" figure, have a statutory basis in 35 U.S.C. 121 which specifies "inventions claimed" and not shown in figures, and whether regulation 809.02(a) M.P.E.P. which relies on such claim identification by illustrations for purposes of withdrawal and rejection is valid under any statute.

13. Whether in the practice of "restriction" of the Patent and Trademark Office withdrawal and rejection of non-species claims en masse on ground of non-readability on one drawing figure is authorized by 35 U.S.C. 282 which requires presumption of validity of each claim independently of the validity of other claims.

14. Whether the Court of Customs and Patent Appeals new claim rejection affirming ground as "separately identified inventions" was not, in fact, precluded by the Patent and Trademark Office non-rejection of the appealed claims under 35 U.S.C 121 as

independent and distinct inventions, they being for inventions related to and dependent from the allowed linking Claims 18-21 and allowed Claim 31.

STATUTES, FEDERAL RULES,
AND REGULATIONS INVOLVED

The pertinent portion of 35 U.S.C. 121 is set out in Appendix D.

Also involved is Title 37 of Code of Federal Regulations 1.141, 1.142, and 1.146 (See Appendixes E, F, and G).

STATEMENT

This matter concerns an application filed in the United States Patent and Trademark Office by Vladimir H. Pavlecka and John Pavlecka for "Resilient Annular Coupling", Serial No. 114,020 filed February 9, 1971.

Referring to the drawings, Appendix H, Petitioners' invention comprises a coupling for two concentric parts, 1 and 2, Figure 1, in an annular space between which coupling 3 is inserted endwise. A nut 15 and a washer 14 axially compress the coupling at one end against thrust face 12 at the other end of the central member or shaft 1, so that the coupling increases in size outwardly and shrinks inwardly due to its particular oppositely inclined webs 9 which alternate between cylindrical engaging lands 10 and 11 on the apex of each two convergent webs in contact with cylindrical engaging surfaces 2 and 5 on the

respective inner and outer coupled members 1 and 4. This web formation is compressed by the nuts 15 and 13 to a predetermined length between the thrust face 12 and shoulder 14 on the inner member or shaft 1, thereby effecting frictional engagement of the coupling formation with the members 1 and 4.

The complete coupling is defined in the allowed linking Claims 18-21; it includes a number of subcombinations which perform cooperatively all the necessary functions for a satisfactory coupling; a chart listing them appears in Appendix I (Page A20); one of them is referred to as "sequential land engaging means" and performs a vital role in the application of the coupling. It is recited in the allowed generic Claim 6 (also in Claims 18-21) as a means for effecting a frictional engagement of the coupling peripheral respective inner and outer engaging lands 10 and 11 with the two enclosing members, sequentially, i.e., one after the other from one coupling end to the other; the object is to prevent a premature seizure of the coupling with the members before the coupling is fully compressed endwise in its final position between the members.

This sequential land engagement can be produced by either one of two species of such "means", which represent two inventions independent structurally but not distinct from each other in their identical function to achieve the sequential land engagement; they are set forth in the allowed species Claims 7-10 and 14,

as seen in the chart at page A29; the species of Claim 7 is further modified by features defined as sub-species in the allowed Claims 8-10.

The species and the sub-species of Claims 7-10 and 14 were disclosed as such, and were the only claims to which restriction under 809.02(a) M.P.E.P. or under 37 C.F.R. 1.146 to one species pending the allowance of a generic claim was applicable; no "restriction" by misrepresenting all non-species claims as "species" and holding them withdrawn or rejected is required by any statute, and is practiced solely by misrepresenting all the non-species claims as "species"; if no generic claim is found allowable only the claim or claims for the elected species out of all the true species presented is allowable, and if a generic claim is found allowable, claims for up to five true species are allowable, and were allowed in this case; all the rest of the non-species claims are allowable as soon as questions of prior art are settled.

THE PROSECUTION IN THIS CASE

Twenty seven claims were filed with this application, of which sixteen now stand allowed and eight are here on appeal.

In the first Office Action, the Examiner made a requirement for restriction in accordance with Section 809.02(a) of the Manual of Patent Examining Procedure (MPEP) which sets forth the practice of the

Patent Office. The Examiner stated that five claims appear to be generic each to anywhere from two to six figures in the drawings (Appendix H); the remaining claims, according to the Examiner, were directed to more than one species of the invention, and named eleven figures which allegedly showed species. Petitioners were required to 1) elect a single disclosed species (by designating the figure illustrating the species), and 2) to list all claims readable on the elected figure; in the event that a generic claim was finally held allowable, Petitioners would be entitled to consideration of claims to no more than four species additional to the elected one.

Petitioners pointed out that the five claims named by the Examiner as being "generic" to certain figures were in total error in the case of four of them, and that according to the disclosure there were six claims defining two species and three sub-species after claims for one species and two sub-species had been cancelled.

Petitioners designated Figures 9 and 10 (two views of the same embodiment) as the "elected" ones, and traversed the requirement for restriction in order to preserve their right to controvert it by a petition to the Commissioner; also, Petitioners warned the Examiner that only claims for species embraced by the same generic claim are withdrawable provisionally pending the allowance of a generic claim (37 C.F.R. 1.146 and M.P.E.P. 809.02(a), paragraph 3).

The Examiner answered this by withdrawing from further consideration under Rule 142(b) twenty claims of which only Claims 7-10 are for genus-embraced species (Claim 14 was not included), and the rest are for the combination and its subcombinations and features of the complete article; Applicants' traverse was stated to have been given "careful consideration" and the requirement for restriction was "believed proper and without error"; the requirement was that but the withholding of the other sixteen claims under Rule 142(b) as "non-elected species" is plainly not called for in that rule which does not even mention any species or a generic claim.

Applicants responded by:

"It has been made clear that the traverse is not directed to the requirement per se,.. but to 1) the designation of all the drawing figures as being each a 'species', and on that false and illegal premise, 2) withdrawing from consideration.... all of the claims--beside the generic one and the 'elected' species one--as being for 'species' not readable on the elected one."

In the Examiner's next letter, Claims 1, 2, 18-21, 24-26, and 28-34 were stated to be non-generically embraced species claims and held withdrawn from further consideration; Claims 6-10, 14, 16, and 17 were allowed, of which Claim 6 is generic, Claims 7-10 and 14 are for species

under it, and Claims 16 and 17 have no species bearing and were allowed probably because they are in dependent form from Claim 6.

With the allowance of the generic Claim 6, and the species claims under it, the purpose of the "restriction" was accomplished; the rest of the claims which were all of the non-species type and not in need of a generic claim should have been allowed, in fact, they should have never been illegitimately "withdrawn" at all. The application should have issued as a patent in 1973.

Petitioners then filed a Petition to the Commissioner of Patents and Trademarks in which they pointed out the inequities of the "restriction" as practiced by the Office which, by eliciting an election of one species figure to represent one preferred species before a generic claim for it and for the other species would be allowed, seized upon this species election as a license, in fact, a mandate to impound all the non-species claims for the major and most important part of the complete inventive article of Applicants; no statutory authority exists for such an act of dispossession of property, and the cited Rules 141 and 142(b) have no power of law over non-species claims that do not need a generic claim.

Applicants presented a thorough outline of the whole case in their Petition to the Commissioner because they expected that their case would have to be decided on an appeal to a court, and they wanted 1) to have all their arguments on record as having

been for consideration of the Patent Office, and 2) to have the claims rejected for an appeal.

The Commissioner complied by directing that "the Examiner should reject the said claims", which was done in the next Patent Office letter.

Petitioners then appealed to the Patent Office Board of Appeals on the basis that 1) the rejection of the non-species claims as being for "species not embraced by an allowed generic claim as required by Rule 141" is a misuse of that indefinite rule, and 2) is contradicted by 35 U.S.C. 121 in that while the species Claim 7-10 were allowed as "independent and distinct" inventions under 37 C.F.R. 1.141, two or more of those claims being prohibited by that statute, the rejected claims for dependent and related cooperative subject matter, such as are not barred by that statute, were rejected under Rule 141 as non-elected and generically non-embraced "species", and 3) furthermore, the instant rejection en masse of the non-species claims on appeal violates flagrantly 35 U.S.C. 282 by failing to establish the alleged lack of validity of each claim independently of the other claims.

In their Brief to the Board of Appeals, Petitioners pointed out that the claims rejection was set up on deception in that the respective references in 37 C.F.R. 1.141 and 1.146 to "generic claim to all claimed species" and "to which his claims shall

be restricted" were taken advantage of to first change the status of all the claims verbally into "species", and then reject them on that status under those rules. Also, merely calling claims "species" does not render them ipso facto rejectable under 35 U.S.C. 121 as independent and distinct inventions, which statute is relied on for the "restriction" to one elected species in M.P.E.P. 809.02(a).

In his answer to Appellants' Brief to the Board of Appeals, the Examiner defended the rejection of the claims as not being "directed to the elected subject matter of Figures 9 and 10", and went to great length to prove the obvious fact that they are not so directed; also, he allowed Claims 18-21.

RESTRICTION AS APPLIED TO THIS CASE

In this case, the appealed claims were not rejected on their merits, i.e., neither under 35 U.S.C. 102, 103 or 112, but under a practice of the Patent and Trademark Office referred to as "restriction"; it has no statutory basis but is a procedure prescribed in M.P.E.P. 809.02(a) and 809.02(c) and relies on the "power of law" of regulations 37 C.F.R. 1.141, 1.142, and 1.146 to impart legality to the requirements imposed by it. By a revision of 1973 Paragraph 3 of 809.02(a) was amended in three places to cite a statute in the clause "Applicant is required to elect a single disclosed species under 35 U.S.C. 121"; this statute fails to support the requirement

because it does not refer to any "species" and it does not refer to any disclosed species but to "inventions claimed".

The term "restriction" is applied by the Patent and Trademark Office in an inexact, loose, and vague meaning to cover a number of different acts; in M.P.E.P. 802.02, it is defined as 1) an election between distinct inventions, and 2) an election between independent inventions, for example, an election of species. In 37 C.F.R. 1.141 it covers yet a third election of up to five independent and distinct inventions as generically embraced species.

In 37 C.F.R. 1.146 it has three different meanings:

- (1) "Claims restricted separately to each of more than one species."
- (2) "That species to which his claims shall be restricted."
- (3) "Restrictions to no more than five species."

In 35 U.S.C. 121 two or more independent and distinct inventions are to be restricted to one such invention.

The broadest and most abused restriction proceeds from the instructions how to apply it to all the claims of an application according to M.P.E.P. 809.02(a) and 809.02(c); the results accomplished by following

these instructions are of two non-related, disparate, contradictory, and startling kinds:

- (1) Restriction to one elected species to serve as a stand-in for up to four other claimed species pending the allowance of a generic claim.
- (2) Withdrawing from further consideration, i.e., restricting from the application all the remaining non-species claims and claims for over five true species.

The above first restriction is useful and desirable in making it possible to claim as many as five inventive embodiments of a generic invention for either a whole device or a portion or subcombination of it; it is carried out under regulations 37 C.F.R. 1.141 or 1.146. The other above restriction has no statutory basis and is imposed as a follow-up of the first one although it should not be connected with it; it misuses the fact that claims for species over five in number or if not falling under the same generic claim are not allowable; that leads to the scheme of verbally converting all of the claims into "species"; this is done unobtrusively by first tagging this term onto all drawing figures, and then transferring it to the claims, according to M.P.E.P. 809.02(a) paragraph 2.

"Clearly identify each ...

of the disclosed species, to which the claims are to be restricted. The species are preferably identified as the species of figures 1, 2, and 3 or the species of examples I, II, and III, respectively."

By this designating the drawing figures as being "species" the claims are identified as being for the alleged species in the drawing figures, and are henceforth treated and disposed of as "species" claims that require a generic claim for allowance; claims for up to five of genuine species are allowed under 37 C.F.R. 1.141 or 1.146. Since most of the claims are non-species claims, that is, not genuine species, they do not need and do not have a generic claim; they are withdrawn from further consideration, as directed in M.P.E.P. 809.02(c), "under Rule 142(b) as not readable on the elected species"; this treatment applies to claims whose generic claim is rejected but is also applied to non-species claims that do not have any, as in this case; when Appellants objected to that because Rule 142(b) (37 C.F.R. 1.142(b)) does not mention any species or a generic claim, the withdrawing basis was switched to "these claims are for species not embraced by an allowed generic claim as required by Rule 141."

Since the claims of a patent, not its specification, measure the invention (Milcor Steel Company v. Fuller Company, 316 U.S. 143, 145) only a consideration of the claims themselves can properly determine whether claims are for genuine species or for no species at

all. In this case, the requirement for restriction requiring the Petitioners to identify each claim with a particular drawing figure provides an unauthorized method for rejecting originally all of their non-species claims, not on any statutory basis, but on the allegation that they are not readable on the figure of the "elected species". The provision that the election was only temporary, pending the allowance of a generic claim for consideration of claims for up to four additional species, is ignored and all non-generically embraced claims, i.e., mostly or entirely non-species claims, are withdrawn and later on perhaps rejected by a petition to the Commissioner of Patents and Trademarks to become appealable. What was to have been a legitimate interim restriction to one species thus becomes, by manipulation and misapplication of the term "species" an illegitimate restriction to all or most of the claims that have no species connotation at all.

In this case, apparently as a smokescreen for the rejection of the non-species claims, the Board of Appeals ignored the allowed generic Claim 6 and stated "We note that no generic claim has been found allowable. Thus, the provisions of 37 C.F.R. 1.141 have not been met". The provision of that regulation for "an allowable claim generic to all the claimed species" was met by Claim 6; naturally, it cannot be met by non-species claims that do not need a generic claim for allowance and are rejected on their falsified species status under 37 C.F.R. 1.141.

In summary, the restriction procedure practiced by the Patent and Trademark Office according to M.P.E.P. 809.02(a) has no statutory basis for converting all the application claims semantically into "species" by association with the drawing figures, also called by design "species". By all dictionaries and sound logic the term "species" should be restricted to those conceptions and patent claims that are generically embraced. The most illogical aspect of the restriction practice is in calling non-species claims "species" and rejecting them on the ground that they do not have the properties of genuine species, i.e., they do not have a genus and do not read on one specific species figure.

SPECIES PROPERTIES NEED DEFINITION

Not only the term "species" needs definition to prevent its misuse for illegitimate claim rejection but also claims for species should have their properties precisely defined for a vital reason; under 37 C.F.R. 1.141 up to five species under an allowed generic claim are admissible even though they are stated to be for "independent and distinct" inventions; rules and regulations can be valid by the authority of 35 U.S.C. 6 if they are not inconsistent with statutes; clearly 37 C.F.R. 1.141 violates 35 U.S.C. 121 which does not permit "two or more independent and distinct inventions" to be claimed.

The terms "independent" and "distinct" with reference to inventions

are defined so vaguely, confusingly, chaotically, and contrarily in the Manual of Patent Examining Procedure that a person after reading those definitions cannot come up with a positive and logical definition of these terms.

Petitioners throughout this case have been advocating a definition of species inventions that would allow up to five of them be patentable, if generically embraced, under 37 C.F.R. 1.141, 1.146, and 35 U.S.C. 121; they have been asserting that species inventions, which in accordance with M.P.E.P. 809.04(f), are mutually exclusive, and in accordance with 806.04(h) are patentable over one another, are physically, structurally or mechanically independent from one another for those reasons; however, they are not and cannot be distinct from one another functionally, in effect, or in result, because they must perform the function of the generic claim, and therefore, must be substitutable for one another; the generic claim encompasses a number of species because though the "means" is different, i.e., independent of one another, their function must be the same, i.e., not distinct from one another. Thus, species as independent but not distinct inventions would be allowable under 35 U.S.C. 121.

THE RESTRICTION REQUIREMENT TO ONE SPECIES
WAS NOT CONTESTED BY APPLICANTS

A misrepresentation is fostered by the Board of Appeals, and reiterated by the Court of Customs and Patent Appeals, that Appellants, by their Petition to the Commissioner sought a review of the requirement for restriction, and allegedly, because "it was decided against them" tried to appeal that requirement to the Board and then to the Court.

That is a distortion because from the record can be learned that Applicants in their traverse of the requirement for restriction stated:

"it has been made clear that the traverse is not directed to the requirement per se,.. but to 1) the designation of all of the drawing figures as being each a 'species' and on that false and illegal premise, 2) withdrawing from consideration ...all of the claims beside the generic one and the 'elected' species one, as being for 'species' not readable on the elected one."

What Applicants petitioned for was that the non-species claims, instead of being withdrawn and forgotten, be rejected instead because such rejection is appealable, and the Examiner failed to reject them as he should have under M.P.E.P. 821. The Commissioner ruled for the rejection:

"... the Examiner should reject the said claims to which the traverse applies."

This was done in the next Office Action, otherwise, this case could not be petitioned for to be decided on a final appeal.

Applicants made a thorough presentation of their case in their Petition to the Commissioner because they expected that they would have to file an appeal not from the restriction to one species, which was proper, but from the restriction and rejection of the non-species claims which deprived them of their most valuable claims; they put forth all their arguments against that illegal act because the Board or a court would simply deny consideration to anything not on record, in fact, that was done anyway by ignoring Applicants' contestations altogether.

The Applicants' request in their Petition that their withdrawn claims be reinstated because their restriction and mass withdrawing were in violation of 35 U.S.C. 112, 121, and 282, was similarly ignored and thus made the subject for the final appeal.

THE OPINION OF THE BOARD OF APPEALS

At the outset the Board of Appeals declared:

"Thus the sole issue before us is whether or not these claims are directed to the

elected species identified by Figures 9 and 10 ..."

Appellants never raised or argued that "issue" because obviously the claims are not directed to the elected species subcombination; therefore, the Board proceeded to make up a different issue, to wit:

"Appellants' basic argument set forth in the Brief relates to the propriety of the requirement to restrict as opposed to a consideration of whether or not the rejected claims are directed to the elected subject matter."

The answer to both of these propositions is no; the last one is disposed of hereinabove, and the first one, i.e., the propriety of the requirement to restrict was never raised or argued against by Appellants in relation to one species provisionally designated for prosecution pending the allowance of a generic claim, as prescribed in the third paragraph of M.P.E.P. 809.02(a). Appellants did argue emphatically against the misuse of the restriction to one species for the withdrawing of all of their non-species claims under the falsified status of them as "species"; as such, they were not readable on that one genuine species which was a pretense for their dispossession as "non-elected species", and were removed from the application as public property.

In its summary, the Board of Appeals did not mention the first named "sole issue" of the readability of the rejected claims on the "elected species" of Figures 9 and 10, but, 1) rejected Claims 1, 2, 24-26, and 28-30 under 37 C.F.R. 1.141, and 2) reversed the rejection of Claims 31-34 under the same regulation.

THE OPINION OF THE COURT OF CUSTOMS AND PATENT APPEALS

This Court echoed the Board of Appeals thesis that:

"The sole issue on this appeal is whether the rejected claims read on the elected species."

Similarly, as the Board did not reject the claims on that issue but on another and different "sole issue", the Court did not affirm the claim rejection on the above issue, but on a new and different one as stated hereinafter.

The Court disclaimed jurisdiction to abolish or amend Patent and Trademark Office rules as proposed by Appellants; however, that does not release the Court from resolving Appellants' contention that the rejected claims are of the non-species type and as such 1) cannot and need not read on a figure of a species, 2) cannot have and do not need a generic claim, therefore, are not rejectable on lack of those properties, and 3) are not rejectable

under 37 C.F.R. 1.141 or 1.146 both of which limit the number of claimed genuine species of one genus; the Court also failed to resolve Appellants' argument that no statute bars the allowance and existence of non-species claims together with species claims. Such findings of these facts would cause the Commissioner of Patents and Trademarks to change the Manual of Patent Examining Procedure accordingly.

Instead of reviewing the opinion of the Board of Appeals vis-a-vis Appellants' opinions and arguments of record, the Court erred by completely disregarding the latter, particularly the en masse rejection of all of the non-species claims without a statutory or a valid regulatory basis. It was the same Court which in a number of cases ruled that:

"Statutory basis of the rejection must be designated."
In re Ornitz, 54 CCPA 1305,
 376 F.2d 330, 154 U.S.P.Q. 453.

The Court did not apparently find "the sole issue on this appeal" of the readability of the rejected claims on the elected species any more credible or valid than the Board of Appeals did, and substituted a new and different basis for the rejection of the claims, viz., that they are for "separately identified inventions" in stated figures of the drawing; by comparing those figures with the figure of the "elected invention" (no longer "species") they were obviously found deficient; on such

pictorial analysis the claim rejection was affirmed.

The reliance of the Court in affirming the appealed claims rejection on a visual comparison of drawing figures has questionable validity because "the claims measure the invention", General Electric Company v. Wabash Company, 304 U.S. 365, 369; also in M.P.E.P. 806:

"... the claimed subject matter must be compared..."

However, this is beside the point because 1) Appellants never contended that their non-species rejected claims read on a species figure, and no statute or valid regulation requires such a test of claim patentability; 2) the rejected claims were first prepared for the rejection by being converted semantically into "species" and no statute or valid regulation underwrites such a conversion of the claims status, 3) no statute bars non-species claims from existing side-by-side with claims for species, and 4) no statute requires that non-species claims be generically embraced to be allowable.

The above are controlling facts in this case argued for by Appellants. The Court erred in not finding that the restriction practice of the Patent and Trademark Office in treating non-species claims as being for species is a false and deceptive basis for their rejection. No statute bars allowance of non-species and species claims together, and on that elementary fact alone it was error not to reverse the claims rejection.

CONCLUSION

The unreversed decision below leaves the vital questions of the "restriction" practice of the Patent and Trademark Office, as raised by Appellants, unresolved and particularly appropriate for this highest Court's discretionary jurisdiction.

For the reasons set forth herein and because the subject matter is of direct concern to thousands of patent attorneys and inventors, it is respectfully urged that this Petition for Writ of Certiorari be granted.

Respectfully submitted,

Ernest I. Gifford
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Dated: SEPT. 14, 1978

CERTIFICATE OF SERVICE

I hereby certify that **THREE COPIES OF** the foregoing PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS **WERE** mailed first class to the attorney of record for Respondent herein, by depositing the **COPIES** in the United States mail, postage prepaid, addressed to:

Solicitor General of the
 United States
 United States Department of
 Justice
 Washington, D. C. 20530

this 14 TH day of SEPTEMBER,
 1978.

ERNEST I. GIFFORD

APPENDIX A

NOTE: This opinion will not be published in a printed volume because it does not add significantly to the body of law and is not of widespread interest. It is a public record. It is not citable as precedent. The decision will appear in tables published periodically.

UNITED STATES COURT OF CUSTOMS
AND PATENT APPEALS

IN THE MATTER OF THE APPLICATION

OF **Appeal No. 77-527**

VLADIMIR HENRY PAVLECKA and
JOHN PAVLECKA

Serial No 114,020

DECIDED: February 9, 1978

RICH, Judge

DECISION

The decision of the Patent and Trademark Office (PTO) Board of Appeals (board) is affirmed.

OPINION

Notwithstanding appellants' voluminous arguments directed at the

PTO's rules and practices relating to restriction and election, which are clearly displeasing to appellants, the sole issue on this appeal is whether the rejected claims read on the elected species. The board twice pointed out that was the sole issue before it, and that was the only question it decided. Our jurisdiction under 35 USC 141 is limited to reviewing decisions of the board. It is not within our jurisdiction as a court of review--it is not within our power--to revise the PTO restriction practice, as appellants would apparently like us to do, by abolishing or amending PTO rules and its MPEP.

The "rejection" here is, of course, not on the merits of the inventions defined in the rejected claims. Appellants correctly point out that "no question of merit or prior art is involved." The rejection goes only to appellants'

right to prosecute the rejected claims in this application in view of their election in compliance with the examiner's requirement under 37 CFR 1.141.

We are, moreover, not reviewing the restriction requirement itself.

Appellants had their "day in court" on that issue by their petition to the Commissioner, which was decided against them. That decision is not appealable here. The examiner was instructed to reject the claims now on appeal as not directed to the elected species, he did so, applicants appealed that rejection to the board, and the board affirmed. Whether the appealed claims are directed to the elected species is the only question before us.

Turning now to that issue, it involves a three-stage inquiry: the scope of the elected invention must be determined; the claim limitations must

be construed; and each claim must be compared with the elected invention.

On the first phase of the inquiry, we conclude that the scope of the elected invention is limited to the subcombination of Figs. 9 and 10 and those other features expressly disclosed in the specification as applicable thereto. As we see it, these include only the lengthwise segmentation of Fig. 14 and the disclosed radial slots of Figs. 1 and 2, noted by the board in its reversal of the examiner's rejection of claims 31-34. Having thus construed the scope of the elected invention, we agree with the examiner and the board that the rejected claims are not readable thereon for the following reasons.

Claims 1, 2, and 28 call for webs with concave flanks, a feature disclosed only in the separately

identified inventions of Figs. 4, 8, 11, and 13. The concave-flank limitations of these claims do not find response in the flat webs of the elected invention.

Claims 29 and 30 include limitations calling for lands of progressively increasing widths, a feature described only with respect to the separately identified invention of Fig. 7, which do not find response in the lands of uniform widths of the elected invention.

Claims 24-26 are combination claims. Claim 24 calls for the combination of the coupling means with a pair of positioning plates, as illustrated by the separately identified inventions of Figs. 2, 3, and

4. Claims 25 and 26 require the combination of two coupling means, as disclosed in conjunction with the separately identified inventions of

Figs. 11 and 12. Neither the plate limitations nor the second-coupling limitation find response in the elected invention.

We have not here concerned ourselves with the possibility that appellants might have the right to prosecute the appealed claims in this application, under Rule 141, because of the presence of an allowable claim generic to the rejected claims. From our reading of appellants' brief, appellants do not appear to seriously contend for the existence of such a generic claim. Indeed, as the Solicitor points out, appellants appear to concede the contrary at several points in their brief.

APPENDIX B

UNITED STATES COURT OF CUSTOMS
AND PATENT APPEALS

Thursday, April 27, 1978

Before: Markey, Chief Judge, Rich,
Baldwin, Lane, Miller, Associate Judges.PETITIONS FOR REHEARINGNo. 77-521. AMERICAN INTERNATIONAL
REINSURANCE CO., INC. v. AIRCO, INC.
The petition for rehearing is denied.No. 77-527 APPLICATION OF VLADIMIR H.
PAVLECKA and JOHN PAVLECKA. The
petition for rehearing is denied.No. 77-9. UNITED STATES v. IMPERIAL
PRODUCTS, INC. The petition for rehearing
is denied. Judge Miller would grant the
petition agreeing that the majority
decision does not require overruling
Pan American Import Corp. v. United States.No. 77-20. UNITED STATES v. DE LAVAL
SEPARATOR COMPANY. The petition for
rehearing is denied.

April 27, 1978

APPENDIX C

PATENT APPEAL NO. 77-527

OPINION AND DECISION OF BOARD OF APPEALS,
AUGUST 20, 1976.

Paper No. 25

Before Mattern and Messenheimer, Examiners-
in-Chief, and Juhasz, Acting Examiner-in-
Chief.

Juhasz, Acting Examiner-in-Chief.

This is an appeal from the decision
of the examiner finally rejecting
claims 1, 2, 24-26, and 28-34 under
Rule 141 on the grounds that these claims
are not directed to the elected species.
Claims 6-10, 14, and 16-21 are allowed.Claims 1 and 31 are illustrative
and reproduced as follows:

1. In an annular coupling
between diametral surfaces on two
structural or machine members
opposedly [sic] inclined transverse
webs and inner and outer diametral
substantially flat lands thereon,
and means compressing said coupling
axially and by reducing the web
inclination bringing said lands
radially into a frictionally seized
engagement with said member surfaces,
said webs having concave flanks and
each two meeting webs forming a
transverse groove of a substantially

circular arc profile interjacent said lands.

31. In an annular coupling between diametral surfaces on two structural or machine members convergently inclined transverse webs and inner and outer diametral substantially flat lands thereon, each two convergent webs forming a transverse groove therebetween inwardly of the land on the juncture thereof, and means applying axial compression on said coupling for a web inclination reduction and a frictionally seized lands-with-member surfaces engagement, said each two convergent webs being divided from each other at least part way through said juncture thereof for a decreased resistance to said inclination reduction.

A reading of the illustrative claims provides an adequate understanding of the invention.

Claims 1, 2, 24-26, and 28-34 stand rejected under Rule 141 on the ground that these claims are not directed to the elected species and are for species not embraced by an allowed generic claim as required by Rule 141 now 37 CFR 1.141.

In reviewing the record in this case we note that in response to appellants' Petition to Review the requirement for restriction and to review the final holding by the Office of August 21, 1973, the application was remanded to the

examiner for action according to Section 821 of the Manual of Patent Examining Procedure. In essence, this section directs the examiner to reject the traversed claims on the ground that the said claims are not directed to the elected subject matter since the propriety of the holding is appealable and not petitionable. Thus the sole issue before us is whether or not these claims are directed to the elected species identified by Figures 9 and 10 which election was made in Paper No. 5 filed July 26, 1972.

Appellants' basic argument set forth in the Brief relates to the propriety of the requirement to restrict as opposed to a consideration of whether or not the rejected claims are directed to the elected subject matter. The examiner, on pages 6-8 of the Examiner's Answer, has rebutted appellants' position relative genus-species relationship adequately and we are in accordance with the position of the examiner.

We need only add, by emphasis, that a requirement for restriction is not tantamount to a rejection of the claims and thus appellants are not entitled to a review of the requirement for restriction under 35 USC 134 which section along with a reading of 35 USC 7 relates to matters involving the rejection of claims. Therefore, matters not directly connected with merits involving the rejection of claims

are not appealable to the Board but, rather, are settled by petition to the Commissioner. See *In Re Hengehold* 58 CCPA 1099, 440 F.2d 1395, 169 USPQ 473.

Appellants' position relative 35 USC 121, 37 CFR 1.141, 1.142 and 1.146 and the several sections of the MPEP referred to has been considered and we are not persuaded thereby.

Under the provisions of 35 USC 6, the Commissioner may establish regulations, not inconsistent with the law, for the conduct of proceedings in the Patent Office. Such regulations or Rules of Practice have the force of law insofar as they are not inconsistent with the statute. See *Land v. Dreyer*, 33 CCPA 1108, 155 F.2d 383, 69 USPQ 602.

In our opinion, we find no inconsistency as alleged by the appellants between 35 USC 121 and the Rules in dispute since, in our opinion, the rules are basically derived from the authority granted the Commissioner under 35 USC 6.

We reemphasize the fact that the claims stand rejected under 37 CFR 1.141 and the propriety of such rejection is the sole issue.

In the instant application, we note that no generic claim has been found allowable. Thus, the provisions of 37 CFR 1.141 have not

been met. The examiner, in the Examiner's Answer, has carefully and correctly compared rejected claims 1, 2, 24, 25, 26, 28, 29 and 30 with the elected subject matter of Figures 9 and 10. We note that the appellants have not disputed the examiner's interpretation of the claims other than to dispute the propriety of the Office in the requirement of the election of species. Accordingly, we will sustain the rejection of claims 1, 2, 24, 25, 26, 28, 29 and 30 under 37 CFR 1.141.

With respect to claims 31-34, in our opinion, the rejection under 37 CFR 1.141 can not be sustained. Although Figures 9 and 10 do not disclose the juncture of the webs to be divided the last paragraph of the specification states that the "disclosed radial slots" are usable on others of the disclosed coupling species. Therefore, although none of the drawings specifically disclose the species of Figure 9 with radial slots, such subject matter is disclosed by original presentation in the specification and thus would support these claims.

Appellants' argument relative to the lack of a statutory basis for the rejection has also been carefully considered and is not persuasive. The rule (37 CFR 1.141) which is the basis of the rejection by the examiner is derived under 35 USC 6 and thus there is a statutory basis for the rejection as we have discussed *supra*.

In summary:

We sustain the rejection of claims 1, 2, 24-26 and 28-30 under 37 CFR 1.141.

We reverse the rejection of claims 31-34 under 37 CFR 1.141.

ARRIRMED-IN-PART (sic)

FRED C. MATTERN, JR.)
Examiner-in-Chief)
A. DONALD MESSENHEIMER)
Examiner-in-Chief)
ANDREW R. JUHASZ)
Examiner-in-Chief)

APPENDIX D

35 U.S.C. 121 - Divisional Applications

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Commissioner may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention.

APPENDIX E

CFR 1.141-Different Inventions In One Application

Two or more independent and distinct invention may not be claimed in one application, except that more than one species of an invention, not to exceed five, may be specifically claimed in different claims in one application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to each species in excess of one are written in dependent form (Section 1.75) or otherwise include all the limitations of the generic claim.

APPENDIX F

CFR 1.142-Requirement for Restriction

(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in his action shall require the applicant in his response to that action to elect that invention to which his claim shall be restricted, this official action being called a requirement for restriction (also known as a requirement for division). If the distinctness and independence of the inventions be clear, such requirement will be made before any action on the merits; however, it may be made at any time before final action in the case at the discretion of the examiner.

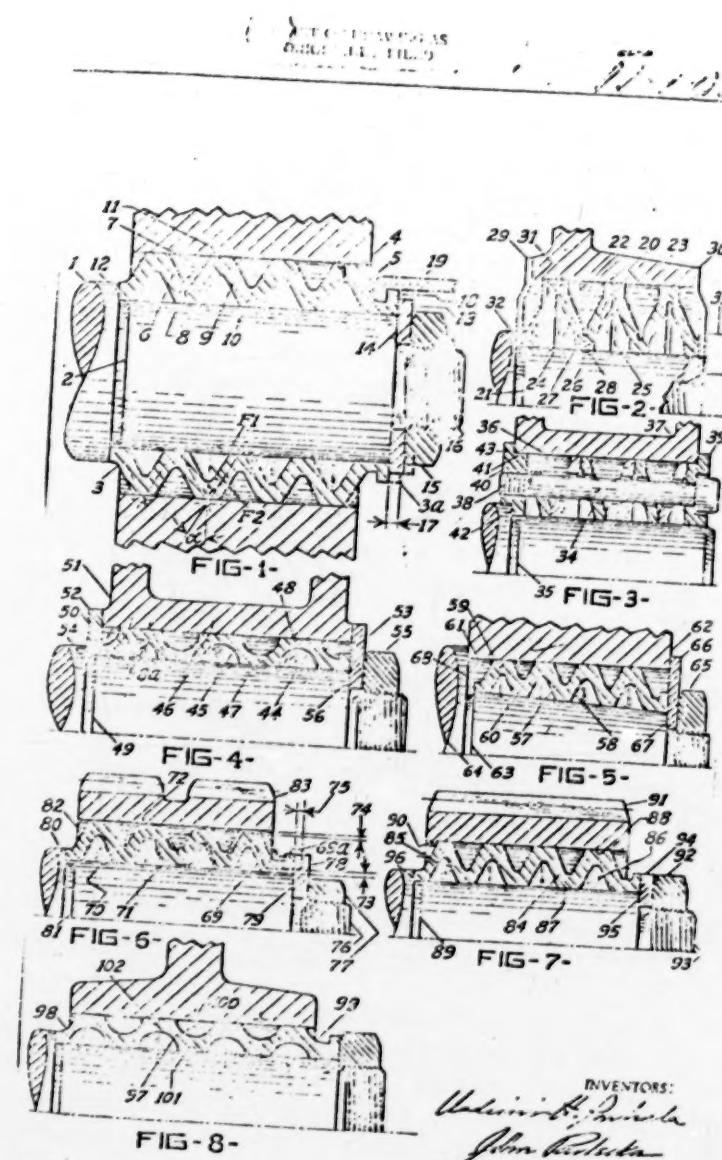
(b) Claims to the invention or inventions not elected, if not canceled, are nevertheless withdrawn from further consideration by the examiner by the election, subject however to reinstatement in the event the requirement for restriction is withdrawn or overruled.

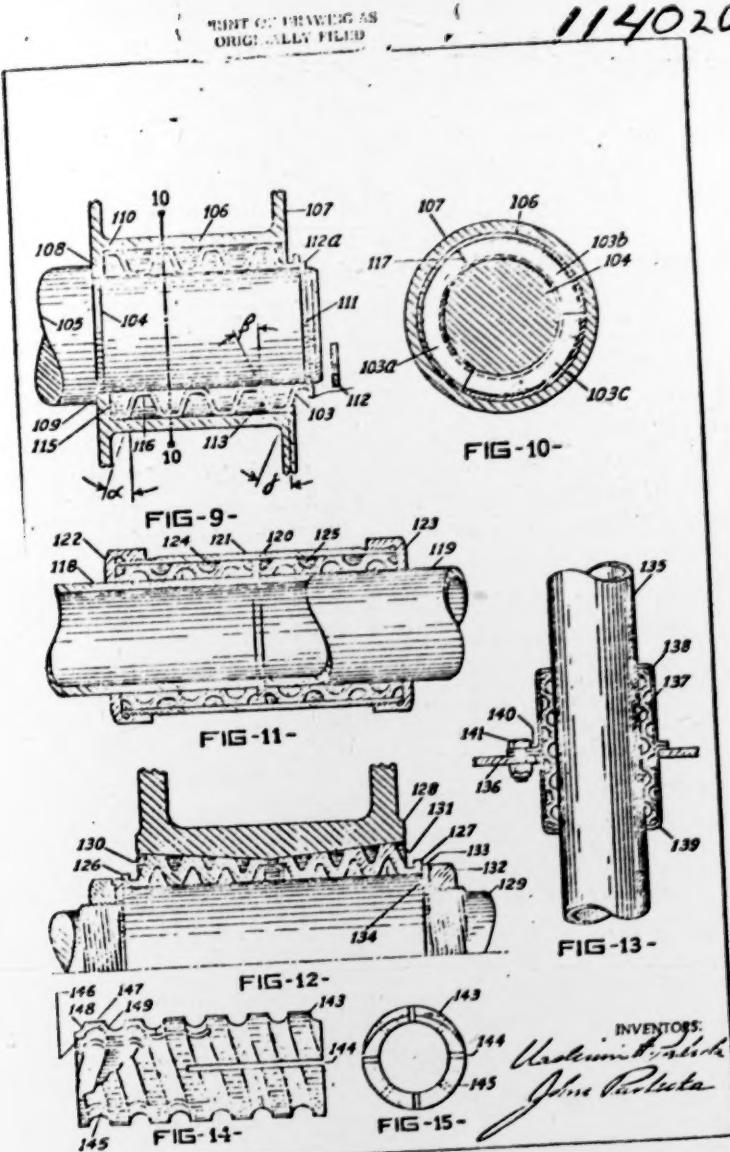
APPENDIX G

CFR 1.146 - Election of Species

In the first action on an application containing a generic claim and claims restricted separately to each of more than one species embraced thereby, the examiner, if of the opinion after a complete search on the generic claims that no generic claim presented is allowable, shall require the applicant in his response to that action to elect that species of his invention to which his claims shall be restricted if no generic claim is finally held allowable. However, if such application contains claims directed to more than five species, the examiner may require restriction of the claims to not more than five species before taking any further action in the case.

APPENDIX H





APPENDIX I

ALLOWED CLAIMS

6. Two structural or machine members forming an annular space between diametral surfaces thereon, a coupling comprising a formation of convexly inclined transverse webs and having inner and outer diametral lands thereon in an initially loose fit between said member surfaces, means on one member for abutment of an inert formation end thereagainst, means for applying axial compression to the formation opposite preload end and by a reduction of the web inclination causing a contraction of said inner lands and an expansion of said outer lands into a frictionally seized engagement with said member surfaces, said webs being of a substantially equal minimal thickness, and means embodied in said formation for effecting said web inclination reduction and land engagement sequentially beginning at said land inert end and ending at said preload end.

7. In the combination of claim 6, said means embodied in said formation for said sequential land engagement residing in said web formation inner and outer lands having said loose fit thereof between said member surfaces progressively increasing in the free condition thereof from said formation inert end to said preload end.

8. In the combination of claim 7, at least one member surface being conical and forming a wider annular space at said coupling preload end than at said inert end, said lands along

said conical surface being divergent therewith in the formation free condition from said inert end to said preload end thereof to provide said increasing loose fit.

9. In the combination of claim 7, said web formation inner and outer lands being each cylindrical, and the lands along each member surface having the diameters thereof stepped off in a cascade receding from said surface toward said formation preload end to provide said increasing loose fit.

10. In the coupling of claim 7, said member surfaces being cylindrical, and said coupling formation inner and outer lands being tapered divergently with respect to the respective member surfaces from said formation inert end to said preload end to provide said increasing loose fit.

14. In the combination of claim 6, said means embodied in said formation for said sequential land engagement residing in said formation webs having a gradually increasing angle of said inclination thereof, the web at said inert end having the least angle and the web at said preload end the largest angle.

16. In the combination of claim 6, said web formation and said inner and outer lands thereon being divided axially into a number of segments at least part way through the length of said formation.

17. In the combination of claim 16, said web formation being divided into said segments by slots extending from both ends thereof past the mid-length, the slots from one end extending intermediate those from the other end.

18. In the combination of claim 6, means on said member bearing said web formation inner end abutment means for limiting said compression application to a predetermined formation length, means for positioning the other member in relation to said abutment means bearing member and to said formation thereon by said compression applying means and by said web formation compressed thereby, a puller engageable means at said web formation preload end for a disassembly of said formation and of said members from each other by releasing said formation lands sequentially in the reverse order of said sequential engagement thereof with said members and simultaneously releasing said means positioning said member on said abutment means member, and means for reducing the applied compressive force and the disassembly pullout force by partly to fully separating portions of said web formation from each other.

19. In the combination of claim 18, said compression and pullout force reducing means residing in each two formation webs being separated from each other at least part way radially through the juncture thereof at each land.

20. In combination of claim 18, said compression and pullout force reducing means residing in said formation webs being each separate annular dished disc bearing one half of each land thereon.

21. In the combination of claim 18, said formation webs having concave flanks and forming arcuate transverse grooves interjacent said lands for a minimal annular coupling size, said webs, lands and grooves being helically convoluted, and said web formation and lands thereon being separated lengthwise into a number of segments through at least a portion of the length thereof for implementing said means for reducing the compressive and pullout forces.

31. In an annular coupling between diametral surfaces on two structural or machine members, convergently inclined transverse webs and inner and outer diametral substantially flat lands thereon, each two convergent webs forming a transverse groove therebetween inwardly of the land on the juncture thereof, and means applying axial compression on said coupling for a web inclination reduction and a frictionally seized lands-with-member surfaces engagement, said each two convergent webs being divided from each other at least part way through said juncture thereof for a decreased resistance to said inclination reduction.

32. In the coupling of claim 31, said each two convergent webs having said juncture thereof divided part way by a circumferential slot in the land on said juncture.

33. In the coupling of claim 31, said each two convergent webs having said juncture thereof divided part way by a circumferential slot in the groove between said webs.

34. In the coupling of claim 31, said each two convergent webs having said juncture thereof divided radially from said land thereon to said groove between said webs.

APPENDIX J

REJECTED CLAIMS

1. In an annular coupling between diametral surfaces on two structural of machine members, opposingly inclined transverse webs and inner and outer diametral substantially flat lands thereon, and means compressing said coupling axially and by reducing the web inclination bringing said lands radially into a frictionally seized engagement with said member surfaces, said webs having concave flanks and each two meeting webs forming a transverse groove of a substantially circular arc profile interjacent said lands.

2. In the coupling of claim 1, said webs and lands and the grooves interjacent thereof being helically convoluted.

24. In a machine or structure, two members forming an annular space therebetween, a resiliently expansible and contractible coupling occupying said space with an initially free fit between said members, means for compressing said coupling axially and causing a frictional seizure thereof with said members, the inner one of said members having two spaced apart faces thereon one larger than the other and turned in the same direction, said coupling having an inert and at said larger face and said compressing means acting upon the coupling other end and abutting the smaller face, and two annular plates astride the opposite sides of the outer one of said members,

said plates being included one between said inert coupling end and said inner member face thereat and the other one between said other coupling end and said compressing means thereat and forming a part of said compression means thereat.

25. In a machine or structure, an outer member and at least one central member forming an annular space therebetween, two couplings occupying said space and being resiliently expanded and contracted by an axial compression into a seized engagement with the respective outer and central members abutment means in said space on a first one of said members reacted against by said couplings in contravening directions, the other member having oppositely turned distances faces thereon, and an annular means engaging said other member at said faces and compressing said couplings to a length limited by a distance therebetween.

26. In the combination of claim 25, two central members forming said annular space with said outer member, a thrust plate as said abutment means in said space retained by said members, said couplings having inert ends abutting said thrust plate, said outer member having threaded portions at said faces thereon, and nuts engaging said threaded portions and effecting said coupling compression limited to the distance between said outer member faces.

28. In the coupling of claim 1, said grooves having the centers of said substantially circular arc profile thereof located progressively further away from the respective inner and outer coupling lands in the direction from a coupling inert end to the other end thereof at said compression means.

29. In an annular coupling between diametral surfaces on two structural or machine members, a plurality of convergently inclined transverse webs and inner and outer diametral substantially flat lands thereon, and means applying axial compression on said coupling for a web inclination reduction and a frictionally seized lands-with-member surfaces engagement, said inner and outer coupling lands having progressively increased widths from one coupling end to the other.

30. In the coupling of claim 29, each two of said convergently inclined webs forming a groove therebetween interjacent said inner and outer lands thereon, the grooves formed by said plurality of webs being of substantially equal depths.

VI. THE SUBJECT MATTER OF THE REJECTED CLAIMS AND COMMENTS THEREON

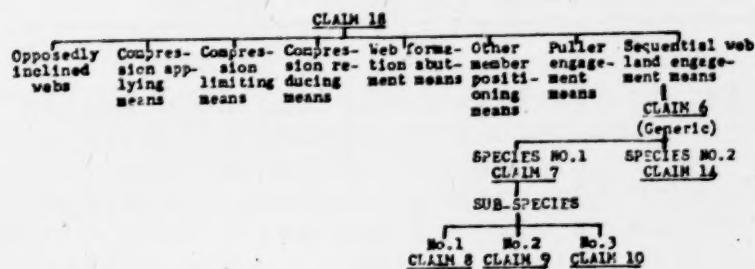
CLAIM 1: Each two coupling webs having concave flanks and forming a groove of substantially circular profile thereby. (FIGS. 4, 11, 13 and 14).

Since no other groove profile --such as the "V" shape-- is claimed the circular profile groove does not amount to a species that would need a genus claim, and this novel and useful shape is included in the combination of the linking claim 21.

CLAIM 2: Helically convoluted coupling webs and lands. (FIG. 14). No straight webs and lands being claimed, the helical ones do not represent a species that would need a genus claim.

CLAIM 18: The elements, some old and others new and inventive, included cooperatively in the combination of this linking claim for the coupling are as follows:

PATENT APPEAL NO. 77-527



CLAIM 19: Each two webs being separated from each other at least part way radially through the junction thereof. (FIGS. 1, 2 and 3).

CLAIM 20: The coupling webs are each a separate dished disc. (FIG. 3). The "at least part way" web separation in claim 19, and the separate webs (i.e., fully separated) or discs in claim 20 are not two species of some genus but merely embodiments of the same concept and means carried out to different degrees.

CLAIM 21: Arcuate helically convoluted lands and grooves, and the web formation separated lengthwise into segments through at least a portion of its length. (FIG. 14.) These two limitations are added to the combination of claim 18 from which claim 21 depends, thus cooperatively linking all of the individually claimed elements essential for the most useful construction of the coupling.

From the diagram of the contents of claim 18 on the preceding page is evident that claim 6 and the species claims 7-10 and 14 for the element of the sequential coupling engagement means do not and cannot embrace the all-inclusive subject matter of claims 18-21, of which that engagement means is merely one element, its species and sub-species being in a subordinate position as alternative or substitutable elements for one another; therefore, the rejection of claims 18-21 and others on the ground that they are not comprehended by the allowed genus claim 6, and that they are not for the "elected" species drawing FIG. 9, is false because it is absurd to expect that the elements of claim 18 could be "embraced" by the single element of claim 6, and the same goes for claims 19-21; some of the elements of claims 18-21 are patentable individually and all of them collectively as dependent, related and cooperative subject matter.

CLAIM 24: Two annular plates astride the coupling ends. (FIG. 2) These plates locate the outer member over the inner one, prevent moisture and dirt from entering the coupling, and retain the outer member in place for safety in case of a coupling failure. This invention is thus dependent upon and related to that of the complete coupling of claims 18-21, and could have been recited as an added limitation to one of these linking claims; being equally well useful for other coupling types and unprecedented in the art, it is properly claimed on its own.

CLAIM 25: Two couplings between an outer member and at least one central one, coupling abutment means on one member, oppositely turned distanced faces on the other one, and means compressing the couplings to the distance between the faces. (FIGS. 11 and 12.) This use of two couplings accomplishes new results in that they couple together three members, and whether they couple together two or three members a centrally locating means for such members in relation to the couplings is provided.

CLAIM 26: A thrust plate retained between two aligned inner members of claim 25 and abutted by the couplings under compression. (FIG. 11.)

This embodiment represents a species of the genus of claim 25, but inasmuch as the other species shown in FIG. 12 is not claimed, such one species is not mutually exclusive with anything else claimed for the same result and does not become an independent and distinct invention--such as species are according to Rule 141--except when two or more are claimed; of course as many as five may be allowed under an allowable genus claim, and claim 27 was filed for the embodiment of FIG. 12 as a second species of the genus of claim 25, but inasmuch as there already are two species and three sub-species claimed under genus claim 6 for an invention depended upon for successful functioning by the couplings of claim 25, the species claim 27 was canceled; this was done most reluctantly because there is no statute or rule excluding two genus claims for related inventions, one dependent upon the other, and as many as five species claims under each such claim in one application. This proposition was left pending for some future case because the rejection of the claims of record as being for "species" and as not being under the allowed genus claim 6 engenders enough argument in itself.

CLAIM 28: The circular profile coupling grooves of claim 1 have their centers located progressively further away from the coupling lands from the coupling inert end to its preload end.

(FIG. 8)
Centers so located produce progressively thicker webs by and between the concave web flanks; webs so proportioned are known between flat flanks of "V" grooved couplings, and the means of obtaining them between the novel and useful concave webs of claim 1, as set forth in claim 28, is inventive matter dependent from and related to that of the former claim as well as that of the linking claim 21; inasmuch as no other means for obtaining progressively thicker webs between circular or arcuate coupling grooves are claimed, claim 28 is non-exclusive with anything else claimed and is not, therefore, an independent and distinct invention from another species of its subject matter, and no law, rule or regulation bars its allowance.

CLAIM 29: Progressively wider coupling lands from one coupling end to the other. (FIG. 7)
Such lands are useful in couplings where the web thickness increases from one end to the other, and inasmuch they are non-existent in the prior art and are not mutually exclusive with anything else claimed, therefore, do not have to be embraced by a generic claim, and are allowable as inventive matter related to and not independent from the type of the disclosed coupling.

CLAIM 30: The grooves between the lands of the increasing width of claim 29 are of equal depth. (FIG. 7.) Such grooves are related structurally to the increasing width lands in couplings employing webs of progressively greater thickness for sequential land engagement, therefore, the inventive matter in claim 30 is not independent of the type of the coupling disclosed which embodies means for such engagement, and is related to the genus of such engagement means.

CLAIM 31: Each two convergent webs are divided at least part way through their juncture. (FIGS. 1-3.) Such divided webs represent a vital improvement in the subject coupling as a means for reducing the

compressive and pull-out forces, which means is recited in the linking claims 18-21; claim 19, dependent from claim 18, recites the at-least-part way divided webs for implementing the "means" of the latter claim, but inasmuch as webs so divided have utility in couplings lacking one or more of the limitations in claim 18, claim 31 is allowable on the merits of such webs alone as a dependent and related invention.

No. 78-454

Supreme Court, U.S.

FILED

NOV 21 1978

MICHAEL RODAK, JR., CLERK

In the Supreme Court of the United States

OCTOBER TERM, 1978

VLADIMIR HENRY PAVLECKA and
JOHN PAVLECKA, PETITIONERS

v.

DONALD W. BANNER, COMMISSIONER OF PATENTS AND
TRADEMARKS

ON PETITION FOR A WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF CUSTOMS AND
PATENT APPEALS

MEMORANDUM FOR THE RESPONDENT
IN OPPOSITION

WADE H. McCREE, JR.
Solicitor General
Department of Justice
Washington, D.C. 20530

In the Supreme Court of the United States

OCTOBER TERM, 1978

No. 78-454

VLADIMIR HENRY PAVLECKA and
JOHN PAVLECKA, PETITIONERS

v.

DONALD W. BANNER, COMMISSIONER OF PATENTS AND
TRADEMARKS

*ON PETITION FOR A WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF CUSTOMS AND
PATENT APPEALS*

MEMORANDUM FOR THE RESPONDENT
IN OPPOSITION

Petitioners contend that the Patent and Trademark Office should not have restricted the claims presented in their patent application.

1. Petitioners filed with the Commissioner of Patents and Trademarks a patent application entitled "Resilient Annular Coupling" (Pet. 6). Their application described several different kinds of coupling devices. These devices are intended to connect concentrically arranged elements, such as a shaft and a rotor, through use of resilient members (Pet. App. A-18 to A-19). The resilient members would expand and contract when subjected to axial pressure, thus frictionally engaging and disengaging the inner and outer elements (Tr. 18-19).¹

¹"Tr." refers to the transcript of record in the United States Court of Customs and Patent Appeals.

The Patent and Trademark Office examiner determined that claims to more than one independent and distinct invention had been presented in the application, and he required petitioners to elect a single species of their invention for consideration in their present patent application.² Petitioners objected to the examiner's requirement but nonetheless elected a species of their invention (Tr. 26-33). The examiner thereafter determined that all claims not relating to the species that had been elected would be "withdrawn from further consideration in this case" pursuant to 37 C.F.R. 1.142(b) (Tr. 37-38).

Petitioners challenged the examiner's restriction requirement and subsequent withdrawal of claims by petition to the Commissioner (Tr. 38). The Commissioner sustained the restriction requirement but directed the examiner to reject any claims that did not relate to the elected species so that the correctness of that determination could be appealed (Tr. 55-56). The examiner then rejected those claims that did not properly relate to the elected species, and the Patent and Trademark Office Board of Appeals affirmed his rejection. The Board of Appeals expressly declined to review the propriety of the

²The statutory authority for the examiner's requirement is 35 U.S.C. 121, which provides in pertinent part:

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application * * * it shall be entitled to the benefit of the filing date of the original application.

The statute is implemented by Patent and Trademark Office regulations, 37 C.F.R. 1.141 *et seq.* (Pet. App. A-15 to A-17). Under 37 C.F.R. 1.142, an inventor presenting two or more separate inventions in a single application is required to elect the invention to be prosecuted.

underlying restriction requirement that had previously been approved by the Commissioner, noting that it had no jurisdiction to do so (Pet. App. A-8 to A-13). The Court of Customs and Patent Appeals affirmed, stating that "the sole issue on this appeal is whether the rejected claims read on [properly relate to] the elected species" (Pet. App. A-1, A-2).

2. As petitioners correctly state (Pet. 13), the eight claims that are involved in this case have not been rejected on their merits.³ In addition, as petitioners concede (Pet. 13), those eight claims do not "read on" the elected species that is now being processed. Petitioners nonetheless contend that the claims that have been removed from consideration have been wrongfully appropriated or given to the public (Pet. 3, 11, 21, 22). Petitioners are plainly wrong, for the eliminated claims are still subject to consideration on their merits by the Patent and Trademark Office and may yet be determined to be patentable. Such further consideration can be obtained by petitioners by filing one or more appropriate divisional patent applications, thus following the procedure spelled out in 35 U.S.C. 121 (see note 2, *supra*). As the Court of Customs and Patent Appeals explained:

The rejection goes only to [petitioners'] right to prosecute the rejected claims *in this application* in view of their election in compliance with the examiner's requirement under 37 C.F.R. 1.141.

Pet. App. A-2 to A-3 (emphasis added). The court's affirmation of the rejection of certain of petitioners' claims does not in any way prejudice or foreclose petitioners' right to consideration of those claims once they have been properly presented. See *In re Hengehold*, 440 F. 2d 1395,

³At the present time, some of petitioners' claims have been found to be allowable by the examiner (Tr. 38, 100), or have been reinstated for consideration by the Board of Appeals (Pet. App. A-13). As stated in the petition, of the 27 claims originally filed in the application, only eight have been removed from consideration (Pet. 8).

1403 n.11 (C.C.P.A. 1971); see also *In re Pavlecka*, 319 F. 2d 180, 185 (C.C.P.A. 1963), where the court previously explained to petitioner John Pavlecka:

The significance of the rejection of [certain] claims *** appears to be misunderstood by appellant who refers to such rejection as "a devious act because it fails to state that the rejection is actually on the merits ***." [But] "the rejection of these claims as not readable on the elected species is not a rejection on the merits but rather a refusal by the examiner to consider them on the merits in this application."

Petitioners' attack on the underlying requirement of the Commissioner restricting them to a single species of invention is not properly raised in this Court. The court below correctly declined to review that question, noting (Pet. App. A-3):

We are, moreover, not reviewing the restriction requirement itself. [Petitioners] had "their day in court" on that issue by their petition to the Commissioner, which was decided against them. That decision is not appealable here.

As the court pointed out in *In re Hengehold, supra*, 440 F. 2d at 1398-1404, review of discretionary decisions by the Commissioner restricting claims presented in a single application must be sought under the Administrative Procedure Act, 5 U.S.C. 701 *et seq.*, and cannot be obtained through the Board of Appeals and the Court of Customs and Patent Appeals. Petitioners could have sought judicial review of the Commissioner's restriction requirement, but they failed to do so. In any event, it is plain that 35 U.S.C. 121 authorizes the Commissioner to sever distinct and independent inventions. The application of that clear statutory authority to the particular facts of this case presents no question warranting this Court's review.

It is therefore respectfully submitted that the petition for a writ of certiorari should be denied.

WADE H. MCCREE, JR.
Solicitor General

NOVEMBER 1978